

REMARKS

In the Office Action, the Examiner rejected claims 21-29 under 35 U.S.C. § 103(a) citing several prior art references, namely, United States Patent Nos. 4,831,930 (Leanna), 3,897,292 (Fukuyama), and 6,067,887 (Kapolnek), and United States Patent Application Publication No. 2003/0309112 (Huang). The claims have been amended to further distinguish the present invention from the cited references.

Claims 21 and 25 are independent and were rejected under 35 U.S.C. § 103(t) based on a combination of Leanna and Fukuyama. Applicant respectfully submits that Leanna and Fukuyama should not be combined as indicated by the Examiner, as Fukuyama is a non-analogous reference with regard to Leanna. While Leanna discloses a cylinder, etc. for cutting, Fukuyama relates to printing not cutting. Very different forces are experienced in these two operations such that one having ordinary skill in the art would not consider looking to Fukuyama to modify or improve Leanna.

A prior-art reference is analogous if

- (1) the art is from the same field of endeavor, regardless of the problem addressed; and
- (2) if not from the same field of endeavor, whether it is still reasonably pertinent to the particular problem to be solved.

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E.g., In re Clay, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992); MPEP Section 2141.01(a). But just because the two references at issue in this case relate to cylinders, does not mean they are from the same field of endeavor. For example, in the *Clay* case, the Office argued that the prior art patent and the application at issue were part of a common endeavor: maximizing withdrawal of petroleum stored in petroleum reservoirs. The Court held that the art is not within the same field of endeavor merely because both relate to the petroleum industry. The application at issue was for storage of refined liquid hydrocarbons; the prior art patent was for the extraction of crude petroleum. *In re Clay*, *supra*, at 659, 23 U.S.P.Q.2d at 1060.

Similarly, in *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 U.S.P.Q.2d 1767 (Fed. Cir. 1993), cited at Section 2141.01(a) of the MPEP, the patents-in-suit were for single in-line memory modules. The prior art at issue was for single in-line memory modules. The Federal Court stated, nonetheless:

The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories.

Id. at 864, 26 U.S.P.Q.2d at 1773 (emphasis added). Even though both the application and the prior art reference described SIMMs, they were still different fields of endeavor.

Leanna and Fukuyama are similarly not in the same field of endeavor. Leanna relates to cutting, whereas Fukuyama relates to printing. These endeavors are different.

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As such, one having ordinary skill in the art cannot be said to look to Fukuyama to modify or improve Leanna.

In In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) the patent involved an improvement in a metal hose clamp having a preassembly hook that was used to maintain the preassembly condition of the clamp and that was disengaged automatically when the clamp was tightened. The Examiner cited a combination of two references to support the rejection of obviousness. The first reference related to a metal hose clamp without the hook, and the second described a plastic hook and eye fastener used in garments. The Federal Circuit held that the second reference was nonanalogous art and therefore reversed the obviousness rejection. Specifically, the court stated:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself...Oetiker's invention is simple. Simplicity is not inimical to patentability.

In the present case, the Leanna reference relates to cutting, while the Fukuyama reference relates to printing. Applicant respectfully submits that, consistent with In re

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Octiker, in the present case, it cannot be said that a person of ordinary skill, seeking to solve a problem of enhancing securement of a cutting die to a cylinder would reasonably be expected or motivated to look to printing cylinders, as cylinders which are used for printing are typically subjected to much lower forces than those used for cutting. As such, Applicant respectfully submits that Fukuyama is non-analogous art, and that it is improper to combine Leanna and Fukuyama. As such, Applicant respectfully submits that the rejection be withdrawn.

Applicant further submits that even if Fukuyama can be said to be analogous, there is no motivation in the prior art to combine the references as asserted by the Examiner. As the Federal Circuit stated in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

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In the present case, the prior art did not suggest the desirability of the modification of Leanna asserted by the Examiner.

A general relationship between the fields of the prior art references to be combined is insufficient to suggest the motivation. See Interactive Techs. Inc. v. Pittway Corp., Civ. App. No. 98-1464, slip op. At 13 (Fed Cir. June 1, 1999), cert. denied, 528 U.S. 1046 (1999) wherein the Court said, "The sole evidence proffered of a motivation to combine was that several prior art patents mentioned there being a similarity between garage door openers and home security systems. However, such limited evidence of there being a general relationship between the fields does not suggest a motivation to combine the particular references here relied upon."

Even when changes from the prior art are "minor" or "simple", an inquiry must be made as to whether "the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes." Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) (quoting Northern Telecom. Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir. 1990)). Applicant respectfully submits that there is no suggestion to combine Leanna and Fukuyama as asserted by the Examiner.

All this being said, independent claims 21 and 25 have been amended to further distinguish the claimed invention from that which is disclosed in the cited references. In

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rejecting claims 21 and 25, the Examiner pointed out that Leanna does not teach a die plate which has magnetic elements disposed within resin and that the rotary die plate is contactably mountable on a metal cylinder without having to use mechanical holding devices including screws and clamps. However, the Examiner asserted that Fukuyama does teach this, and asserted that it would have been obvious to combine the references. In asserting that Fukuyama discloses a die plate which has magnetic elements disposed within resin and that the rotary die plate is contactably mountable on a metal cylinder without having to use mechanical holding devices including screws and clamps, the Examiner identified part number 2 as being the "rotary die plate". However, Fukuyama teaches that part number 2 is mechanically (not magnetically) fitted on the printing cylinder (see col. 3, lines 20-21), and that the base plate 4 of this component (which contacts the cylinder 1) is non-magnetic (see col. 3, line 26). Claims 21 and 25 specifically claim that the inner surface of the die plate is magnetically attractable and magnetically mountable on the metal cylinder, and have been herein amended to specifically claim that the inner surface of the rotary cutting die is magnetically attracted to the metal cylinder such that the inner surface of the rotary cutting die is contactably mountable on the metal cylinder without having to use mechanical holding devices including screws and clamps. This cannot be said to be the case in Fukuyama because in Fukuyama the saddle (2) is mechanically fitted on the cylinder, and the inner surface (4) is non-magnetic. Applicant respectfully submits that none of the cited references, either

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alone or in combination, disclose or suggest providing what is now being specifically claimed in claims 21 and 25. Therefore, Applicant respectfully asserts that claims 21 and 25, and those claims which depend therefrom, are allowable.

Claims 21 and 25 are fundamentally different than Leanna and Fukuyama. Claims 21 and 25 specifically claim a rotary die plate which has a cutting blade mounted on its outer surface, which is formed of a solidified resin having a plurality of magnetic elements disposed within the resin, and which has an inner surface magnetically attracted to the metal cylinder. In contrast, Leanna and Fukuyama disclose magnetic cylinders, not die plates having magnetic elements within resin. In Leanna, the core 12 is non-magnetic (see col. 4, line 2), and parts 14, 15 and 16 form part of the cylinder, not the die plate which holds the cutting blades. Also, in Fukuyama, a pair of saddles 2 are provided for mechanically fitting to a cylinder 1. As such, a magnetic cylinder is ultimately formed, not a die plate which has magnetic elements disposed in resin. Among other reasons, because neither reference, either alone or in combination, can be said to teach a rotary die plate which has a cutting blade mounted on its outer surface and which is formed of a solidified resin having a plurality of magnetic elements disposed within the resin, Applicant respectfully asserts that claims 21 and 25, and those claims which depend therefrom, are allowable.

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Applicant respectfully submits that none of the cited references, either alone or in combination, disclose or suggest the present invention. Should the present claims not be deemed adequate to effectively define the patentable subject matter, the Examiner is respectfully urged to call the undersigned attorney of record to discuss the claims in an effort to reach an agreement toward allowance of the present application.

Respectfully submitted,

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